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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

WILSON, MICHAEL C

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| ART UNIT | PAPER NUMBER |
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1632

DATE MAILED: 12/11/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/757,054

Applicant(s)

PETITTE ET AL.

Examiner

Michael C. Wilson

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 November 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 44-54.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

MICHAEL C. WILSON
PATENT EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): 1) Applicant's amendment to claims 49 and 50 have overcome the rejection regarding "derived" (pg 6 of the previous office action); however, parent claims 47 and 48 have not been similarly amended. Therefore, claims 47 and 48 remain rejected for reasons of record regarding "derived." 2) The 102(e) rejection regarding US Patent 6,333,192, on pg 10 (item 8), of the previous office action has been withdrawn because the instant application is a continuation of '192 and a terminal disclaimer over '192 has been filed; 3) The 102(e) rejection regarding Pettite (US Patent '242) has been withdrawn because the instant application has an effective filing date of 8-9-99 which is prior to 3-23-00, the filing date of '242; 4) The double patenting rejection regarding US Patent 6,333,192, on pg 13 (item 14), has been withdrawn in view of the terminal disclaimer filed.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argue claim 44 has support on pg 11, lines 11-12. Applicants argument is not persuasive. While pg 11, lines 11-12, states the culture of the invention may include a feeder matrix, and lines 16-23 states the feeder cells may be "preconditioned," the citations do not contemplate combining PGCs and stromal cells collected from an embryo after stage 14 with the "preconditioned feeder matrix." While pg 10, line 17, suggests isolating avian cells having an ES cell phenotype "from avian gonadal cells comprising primordial germ cells collected from an avian embryo," the citation does not suggest combining avian stromal cells collected from an embryo with the PGCs or that the embryo was later than stage 14. While pg 10, line 6, states embryos from which cell are obtained are preferably after stage 14, the citation does not state both the PGCs and stromal cells are isolated from an embryo after stage 14. While pg 10, lines 14-16, states "embryonic gonadal PGCs and stromal cells may be collected from the embryonic gonads," the citation does not support the breadth of combining any avian PGCs and avian stromal cells isolated from an avian embryo. The citation on pg 10, line 14, is limited to isolating cells from "the embryonic gonads," not isolating cells from anywhere in the embryo as broadly encompassed in claim 44. In addition, the citation on pg 10, line 14, is limited to collecting "gonadal PGCs and stromal cells," not any "PGCs" as broadly encompassed in claim 44. Pg 11, lines 3-10, does not teach stromal cells are genital ridge cells. While pg 11, line 13-15, supports a feeder matrix derived from the gonad, the citation does not suggest the matrix is preconditioned when derived from the gonad or that the cells isolated are "gonadal" (claim 47) Gonadal cells have a different scope than cells of the gonad because "gonadal cells" may be limited to cells having gonadal function while cells derived from the gonad can be cells that provide gonadal function as well as structural cells that do not provide gonadal function. Pg 11, lines 13-15, and pg 19, lines 14-16, do not suggest isolating feeder matrix from the "genital ridge" (claim 48). Pg 10, lines 1-9, and pg 11, lines 13-15, do not contemplate the feeder matrix isolated from "gonadal cells" or "genital ridge" is after stage 14 (claims 49-50). Pg 14-, lines 4-7, does not contemplate the ES cell phenotype is sustained for at least one or two months (claims 53-54). Instead it contemplates culturing PGCs that develop into cells having an ES phenotype and that the culture is sustained for one or two months. The citation is not limited to maintaining the ES cell phenotype for one or two months and does not teach culturing cells after they have the ES cell phenotype. The claims remain rejected for reasons of record under 112/1st, new matter.

Applicants argue Example 4 and pg 14, lines 45, enable cultures of PGCs and feed cells sustained for one or two months (claims 53-54). Applicants argument is not persuasive. Example 1 merely teaches isolating gonadal PGCs and stromal cells. The cells were not sustained for one or two months. Example 2 merely teaches culturing gonadal PGCs and STO feeder cells for 3-5 days. Example 3 merely teaches culturing gonadal PGCs and preconditioned STO feeder cells for two days. Example 4 merely teaches culturing gonadal PGCs and different concentrations of STO feeder cells for two days. The claims remain rejected for reasons of record under 112/1st, enablement.

Applicants arguments regarding 112/2nd have been considered and are not persuasive. The claims remain rejected for reasons of record under 112/2nd.

Applicants argument regarding Allioli is not persuasive because the claim merely requires the PGCs have an "ES cells phenotype." The definition of "germ cell" provided is over limiting as "germ cells" are "a gamete or one of its antecedent cells (Merriam-Webster; <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=germ+cell>). The claims remain rejected for reasons of record over Allioli under 102.

Applicants arguments regarding Chang, Pettite (US Patent '740, '479 and '510) and Ponce de Leon (US Patent '569) have been considered but are not persuasive. The claims remain rejected for reasons of record over Chang, Pettite (US Patent '740, '479 and '510) and Ponce de Leon (US Patent '569) under 102.

Continuation of 10. Other: The terminal disclaimer filed 11-27-02, paper number 13, over US Patent 6,333,192 has been entered..